

REMARKS

At the outset, applicants thank the Examiner for the time and consideration of the present application at the interview with the undersigned.

Claims 19-43 are pending in the application. Support for claims 19-43 may be found generally throughout the specification and in the original claims. Claims 1-18 have been canceled.

In the outstanding Official Action, claims 8 and 13 were rejected under 35 USC §112, second paragraph, for allegedly being indefinite. Applicants believe the present amendment overcomes this rejection.

As noted above, claims 8 and 13 have been canceled. Applicants believe that the new claims have been drafted to avoid the informalities identified in the rejection.

Claim 14 was rejected under 35 USC §103(a) as allegedly being unpatentable over FOSCANTE et al. in view of PLUEDDEMANN. This rejection is respectfully traversed.

The present invention relates to a composition to be used in paints. The invention is based on the unexpected finding that by using the three components, i.e. a non-aromatic epoxy resin, a polysiloxane and an epoxysilane, as recited in the claims, paints with improved properties, e.g. weather resistance, are obtained.

FOSCANTE et al. describe a composition, which may contain a polysiloxane, an epoxy resin and an epoxysilane. The document refers to U.S. 3,183,198 (WAGNER), relating to a completely different field, for the proposition that the epoxy resin can be non-aromatic. The aim of the invention according to FOSCANTE et al. is to improve the solubility resistance of the epoxy system. The reference is totally silent with respect to the use of the now claimed combination of the components in paints resulting e.g. in improved weather resistance. Applicants disagree with the statements of the Official Action that a person skilled in the art would have looked at PLUEDDEMANN in order to choose a suitable epoxysilane for obtaining a paint with improved properties.

PLUEDDEMANN discloses the preparation of epoxyalkylsiloxane at an elevated temperature for use in casting resins. It relates to an intermediate product and the purpose is to avoid the formation of the hydrolytically unstable group SiOC. This is achieved by using peracids or other compounds containing a C=C-bond. The reference in question is not relevant with respect to the present invention.

Thus, in view of the above, applicants believe that one of ordinary skill in the art would lack the motivation to combine and modify FOSCANTE et al. in view of PLUEDDEMANN.

The Examiner is reminded that a critical step in analyzing obviousness pursuant to 35 U.S.C. §103(a) is casting

the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, only guided by the publications and then-accepted wisdom in the field. Close adherence to this methodology is important in cases where the invention itself may prompt an Examiner to "fall victim to the insidious effect of a hindsight syndrome, wherein that which only the invention taught is used against its teacher." Indeed, to establish a prima facie case of obviousness, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ 2d 1313, 1362 (Fed. Circ. 2000). The fact that the prior art could be so modified would not have made the modification itself obvious unless the cited publications themselves suggested the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Circ. 1984).

In light of the lack of a motivation, suggestion or teaching of the desirability of making the claimed combination, applicant believes that one skilled in the art would simply lack the motivation to combine and modify the disclosures to obtain the claimed invention.

Moreover, even if one of ordinary skill in the art were to combine the two publications, there would still be no recognition of the unexpected results exhibited by the claimed composition. As noted above, the invention is based on the

unexpected finding that by using the three components (i.e. a non-aromatic epoxy resin, a polysiloxane and an epoxysilane) as recited in the claimed invention, a paint with improved properties is obtained. This is clearly demonstrated in the present specification. Beginning on page 6 of the present specification, several examples are provided that compare the claimed composition to polyurethane and epoxy paints. The results discussed on page 9 indicate that the claimed composition unexpectedly exhibits an improved weather resistance and adhesive properties under corrosive conditions than polyurethane and epoxy paints.

As discussed at the interview, two declarations have also been filed to provide even further evidence of the unexpected results exhibited by the claimed invention. Copies of these declarations are provided for the convenience of the Patent Office.

Thus, it is respectfully submitted that one of ordinary skill in the art would lack the motivation to combine and modify the publications in a manner so as to obtain the claimed invention. Moreover, even if one of ordinary skill in the art were to combine the inventions, the combination would still not result in the claimed invention. Thus, in view of the above, applicants respectfully request that the rejection be withdrawn.

Claim 14 was rejected under 35 USC §103(a) as allegedly being unpatentable over HOEHN et al. in view of PLUEDDEMANN. This rejection is traversed.

HOEHN et al. disclose a casting resin system including an epoxyalkylsiloxane. Said epoxyalkylsiloxane is a separate semiproduct, the production of which requires a silanol (not encompassed by the claims). HOEHN et al. relate to a totally different field and has nothing to do with paints.

As noted above, PLUEDDEMANN discloses the preparation of epoxyalkylsiloxane at an elevated temperature for use in casting resins.

Thus, even if one of ordinary skill in the art were to combine the publications, one skilled in the art would still not obtain the claimed invention. There is simply no recognition of the claimed combination of components or that such a combination would be useful in a paint composition.

Claim 14 was rejected under 35 USC §103(a) as allegedly being unpatentable over GASMENA in view of PLUEDDEMANN. This rejection is respectfully traversed.

GASMENA discloses a heat ablative coating composition prepared by combining an epoxy silane resin, an epoxy resin, a silicone-intermediate, a silicon-modified polyether, an aminosilane, a solvent, water, at least one filler, optional non-silicon-containing amine catalyst, and optional pigments and thixotropic agents.

However, applicants respectfully note that the claimed composition does not include silicon-containing polyether as relied upon by GASMENA. The specification teaches that the claimed composition provides a number of advantages over existing epoxy-resin-based compositions (page 6, lines 15-29). Moreover, the declaration submitted with the response of January 24, 2005 demonstrates that when silicon-containing polyethers are left out of the composition, a paint composition with a significantly improved gloss retention and a lower color difference is obtained.

As noted above, PLUEDDEMANN discloses the preparation of epoxyalkylsiloxane at an elevated temperature for use in casting resins. In this regard, PLUEDDEMANN fails to remedy any of the deficiencies of GASMENA for reference purposes.

Thus, applicants respectfully submit that the proposed combination of GASMENA in view of PLUEDDEMANN fails to disclose or suggest the claimed invention.

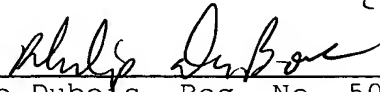
In view of the present amendment and the foregoing remarks, applicants believe that the present application is in condition for allowance at the time of the next Official Action. Allowance and passage to issue on that basis is respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 25-0120 for any additional
fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

The Appendix includes the following items:

- two declarations by Mika PERÄLÄ